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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,856	12/31/2001	Dilip Wagle	361331-507	4036

30623 7590 06/06/2005

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EXAMINER

DELACROIX MUIRHEI, CYBILLE

ART UNIT PAPER NUMBER

1614

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/036,856		WAGLE ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Cybille Delacroix-Muirheid		1614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Detailed Action***

1. Claims 1-2, 4-7 are rejected under 35 U.S.C. 102(e) as being anticipated by Wagle et al, 2002/0022622 A1.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

***Response to Amendment(s)***

The following is responsive to the amendment received Jan. 14, 2005.

No claims are cancelled. No new claims are added. Claims 1-7 are currently pending.

The previous claim objection set forth in paragraph 1 of the office action mailed Nov. 15, 2004 is withdrawn in view of applicant's amendment and the remarks contained therein.

The previous claim rejection under 35 USC 112, second paragraph, set forth in paragraph 2 of the office action mailed Nov. 15, 2004 is withdrawn in view of applicant's amendment and the remarks contained therein.

However, applicant's arguments traversing the previous claim rejection under 35 USC 102(e) over Wagle et al., 2002/0022622, set forth in paragraph 3 of the office action mailed Nov. 15, 2004 have been considered but are not found to be persuasive.

Said rejection is maintained essentially for the reasons given previously in the office action mailed Nov. 15, 2004 with the following additional comment.

Applicant argues Wagle fails to teach that the compounds of the instant invention can be utilized to decrease intraocular pressure or diminished ocular accommodation in

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an animal with increased intraocular pressure or diminished ocular accommodation. In other words, Wagle does not teach administering the claimed compounds to decrease intraocular pressure or improve ocular accommodation in an animal in need thereof. Therefore, Wagle does not anticipate the claimed method.

Said arguments have been considered but are not found to be persuasive.

The Examiner respectfully submits that Wagle may not specifically teach treating “decreasing intraocular pressure or improving ocular accommodation in an animal in need thereof”, however, the target patient population embraced by the claims is disclosed in Wagle. According to applicant’s specification, page 3, lines 1-7, patients to be treated with the claimed compounds are those suffering from diabetes. Wagle et al. teach a method of treating diabetic retinopathy by administering to the patient applicant’s claimed compound, 2,4,5-trimethylthiazole.

Therefore, the examiner respectfully maintains the claims are anticipated by Wagle et al. because Wagle et al. teach administration of an identical active agent, i.e. 2,4,5-trimethylthiazole, in identical effective amounts (see specification page 20, lines 23-27; page 21, lines 22-23 ) to a host in need thereof, i.e. patient suffering from diabetic retinopathy. Accordingly, a decrease in intraocular pressure or an improvement in ocular accommodation in the patient would be an inherent characteristic of the disclosed method.

### ***Conclusion***

Claims 1-2, 4-7 stand rejected.

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**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Cybillie Delacroix-Muirheid** whose telephone number is **571-272-0572**. The examiner can normally be reached on Mon-Thurs. from 8:30 to 6:00 as well as every other Friday from 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Christopher Low**, can be reached on **571-272-0951**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

CDM

June 2, 2005

  
RAYMOND HENLEY III  
PRIMARY EXAMINER

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